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IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

WARNER-JENKINSON COMPANY, INC.,
Petitioner,
v.

HILTON DAVIS CHEMICAL CO.,
Respondent.

On Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

**BRIEF OF THE DALLAS-FORT WORTH
INTELLECTUAL PROPERTY LAW ASSOCIATION
AS AMICUS CURIAE URGING AFFIRMANCE**

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INTEREST OF THE AMICUS CURIAE*

Formed in the mid-1950s, the Dallas-Fort Worth Intellectual Property Law Association is a regional association of persons concerned with the patent, trademark, copyright, trade secret, and other laws protecting intellectual property rights. The Association, which was formerly known as the Dallas-Fort Worth Patent Association, is a member of the National Council of Intellectual Property Law Associations.

The Association's over 100 members, mostly attorneys, regularly represent clients in patent litigation, advise clients on business and licensing matters involving patent issues, and

* The parties' letters of consent have been filed with the Clerk pursuant to Rule 37.3.

represent clients in administrative proceedings before the United States Patent and Trademark Office. The members' clients are split roughly evenly between patent owners and accused infringers. In their role as advisors, the Association's members are regularly called upon to analyze and make judgments as to whether particular manufacturing and sales activities infringe patents, including under the doctrine of equivalents. The Association's attorney members also represent individuals, universities, and small and large businesses in the trial and appellate stages of patent-infringement litigation.

Neither the Association nor any of its members has any direct interest in any of the parties or in which side prevails in this lawsuit, except to the extent that the outcome affects the administration of the patent laws. A principal object of the Association is to aid in the institution of improvements in the patent laws and court procedures for administering those laws. To promote that objective, this *amicus curiae* brief sets forth the Association's observations, reflecting its members' experience in advisory and litigation matters, on the role a properly tailored doctrine of equivalents plays in ensuring just and effective protection of inventors' labors while at the same time promoting predictability in the outcome of patent disputes.

SUMMARY OF ARGUMENT

Our patent system is a vital driver of American ingenuity and the doctrine of equivalents is a vital part of that system. For the reasons well-stated by other *amici*, including the United States, the American Intellectual Property Law Association, and the Intellectual Property Owners, the doctrine of equivalents neither was impliedly repealed by the 1952 codification of the patent laws nor is it inconsistent with the provisions for patent reissuance. Properly tailored, the doctrine of equivalents strongly promotes the purposes underlying the Patent Code. The Association accordingly

urges the Court to reaffirm the continuing existence of the doctrine of equivalents in patent infringement cases.

Like jury cases charging literal infringement, doctrine-of-equivalents cases involve roles for both judge and jury. Once the judge has determined the legally proper interpretation of the patent claim, it should be the jury's province to determine whether the accused product¹ differs only insubstantially from that interpretation. Because this comparison depends on the particular characteristics of the patent claim and the accused product, it cannot be reduced to broad, rigid rules. It is inherently a factual *application* of patent claims, not a legal *interpretation* extending them; indeed, such an extension would invade Congress's authority, properly delegated to the Patent and Trademark Office, to determine what patents shall issue.

As articulated by the Federal Circuit's decisions, the doctrine of equivalents is not a license for the jury to engage in an unguided inquisition. Instead, there are a variety of legal constraints that restrict jury consideration of the doctrine in many cases. Alarmist predictions that American industry will be devastated are contrary to the long history of jury involvement in doctrine-of-equivalents cases. The Court should endorse the jury's continuing role in factually applying the doctrine of equivalents.

After deciding these two fundamental aspects of the doctrine of equivalents—its continued existence and the role of the jury—for prudential reasons the Court should refrain from dictating the exact contours of the doctrine. Predictability requires a substantial body of doctrine-of-equivalents caselaw continually adjusted to the myriad contexts in which inventions are made

¹ Inventions involving products, processes, and compositions of matter may be patented. 35 U.S.C. § 101. Although the same considerations apply for these different classes of invention, for simplicity this brief refers to accused and patented products only.

and patents are awarded. This Court's broad mandate to promote uniform application of all federal laws prevents it from devoting the resources these adjustments require. The Federal Circuit, however, with its nationwide patent-law jurisdiction, decides dozens of cases each year involving the doctrine of equivalents and has both the opportunity and expertise to maintain a uniform, detailed, and up-to-date caselaw. In its disposition of this case, the Court should leave to the Federal Circuit the flexibility to establish and adjust the detailed contours of the doctrine.

ARGUMENT

I. Some Form of the Doctrine of Equivalents, Which Is a Long-Standing and Essential Part of this Country's Plan for Encouraging Innovation, Should Be Continued.

Since before American ingenuity burst into the world's consciousness at the London Crystal Palace Exhibition in 1851,² our patent system has been a powerful engine promoting technological advancement. As summed up by Abraham Lincoln: "The Patent System added the fuel of interest to the fire of genius."

Two features in particular have contributed to the success of our patent system. The metes-and-bounds, or "peripheral," claiming system, an American innovation to patent law begun

² This exhibition transformed America's reputation almost overnight from that of a backward, rural country to one of technical excellence and ingenuity. For an account of this transformation, see BROOKE HINDLE & STEVEN LUBAR, *ENGINES OF CHANGE: THE AMERICAN INDUSTRIAL REVOLUTION* 249-68 (1986), and the exhibition of the same name on permanent display at the National Museum of American History.

in 1822,³ provides definite scope to patents so that inventors and the public alike can know with reasonable certainty what has been patented. Under this system, literal infringement is determined by answering the question whether an accused device is identically described by one or more of the patent's claims.

Because this inquiry, without more, "would place the inventor at the mercy of verbalism,"⁴ this Court long ago endorsed a doctrine of equivalents to prevent evasion of patents by insubstantial changes.⁵ The doctrine has withstood the test

³ Earlier patents contained only a "specification," which described and showed the invention in technical terms and enabled its practice by those skilled in the art. Under this "central" claiming system, the scope of a patent was determined by comparing the invention as described and shown with the accused infringement. Our present patent laws, in contrast, require an applicant to submit claims, which are carefully scrutinized and sometimes revised by the Patent and Trademark Office, thereby legally defining the patent's coverage. 35 U.S.C. § 112, first paragraph (1988). For accounts of the historical development of patent claims, see generally 2 DONALD S. CHISUM, *PATENTS* § 8.02, at 8-5 to -13 (1995); Karl B. Lutz, *Evolution of the Claims of U.S. Patents* (pts. 1-3), 20 J. PAT. OFF. SOC'Y 134, 377, 457 (1938); *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1530-31 (Fed. Cir. 1995) (Newman, J., concurring), cert. granted, 64 U.S.L.W. 3574 (Feb. 23, 1996); and *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1560-61 (Fed. Cir. 1991).

⁴ *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 607 (1950).

⁵ *Winans v. Denmead*, 56 U.S. (15 How.) 330, 342-43 (1854).

of time, gaining increasing international acceptance⁶ as a vital adjunct to literal infringement.

Amicus agrees with the many other bar and industry groups that support continuation of the doctrine of equivalents in some form.⁷ The doctrine adds equity to the quest for balance between the interests of patentee and accused infringer. It softens the harsh edge between literal infringement and no infringement. Fairness cannot be reached in infringement cases without some form of this doctrine. As the United States succinctly states in its amicus brief: "A clearly defined doctrine of equivalents serves the goals of the Patent Act."⁸

To preserve a just and effective patent system as we have today, one which fairly balances the interests of the patentee and the public at large, the Court should reaffirm the continued existence of some form of the doctrine of equivalents.

⁶ As other countries moved from central claiming to peripheral claiming systems, many adopted doctrines similar to the American doctrine of equivalents, although often in diluted form. See generally INTERNATIONAL PATENT LITIGATION: A COUNTRY-BY-COUNTRY ANALYSIS (Michael Meller ed., 1996 & Supp.). Indeed, even the courts of Japan, which traditionally accorded patents only narrow scope according to the literal language of their claims, have recently adopted a doctrine of equivalents. *Genentech Inc. v. Sumitomo Pharmaceuticals Co.* (Osaka, Japan, High Court Mar. 29, 1996).

⁷ See Brief of Amicus Curiae American Intellectual Property Law Association in Support of Neither Party at 3 ("the doctrine must remain available to patentees"); Brief Amicus Curiae of Intellectual Property Owners in Support of Petitioner at 3-4; Brief on Behalf of the American Automobile Manufacturers Association as an Amicus Curiae in Support of the Petitioner at 5; Brief for Information Technology Industry Council and Intel Corporation as Amici Curiae in Support of Petitioner at 3-4.

⁸ Brief for the United States as Amicus Curiae at 14 (section heading).

II. In Doctrine-of-Equivalents Cases, the Jury Should Continue Its Role of Comparing the Patent Claims, as Interpreted by the Court, with the Accused Product.

Determining if a patent has been infringed, whether by literal infringement or by the doctrine of equivalents, is a two-step process involving both legal conclusions and factual findings. As the Court held in *Markman v. Westview Instruments, Inc.*, 64 U.S.L.W. 4263, 4267 (Apr. 23, 1996), the first step is the trial court's legal interpretation of the patent claims as issued. The second step is comparison of the properly interpreted claims with the accused product: does the product have the claimed characteristics, either exactly (for purposes of literal infringement) or with only insubstantial differences (for purposes of the doctrine of equivalents)?

In *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, the Court recognized that the assessment of whether an accused product differs only insubstantially from a patent claim is a determination of fact. Because this comparison depends on the particular attributes of the accused product and the scope of the patent claim, viewed in the context of the prior art, it "is not the prisoner of a formula and is not an absolute to be considered in a vacuum." 339 U.S. 605, 609-10 (1950).

Because assessment of whether differences are substantial rests on many case-specific factors and "requires a balancing of credibility, persuasiveness and weight of evidence," *id.*, it should be viewed as a factual application of properly interpreted patent claims, not a further legal interpretation of them.⁹ Even in literal infringement cases, care must be taken

⁹ In some cases, issues of claim interpretation will be relevant to the doctrine of equivalents, and under *Markman* that interpretation will be a matter to be decided by the judge. For example, where the substantiality of differences is determined by assessing whether the accused product exhibits substantially the same function, way, and

to segregate interpretation of a claim (by a judge) from application of that interpretation (by the jury). Like any language, English has an inherent limit beyond which definitions cannot meaningfully elaborate. Appropriate demarcation of this boundary between interpretation and application should be guided by the degree to which the question involves generally applicable issues of claim scope rather than the specific circumstances of a particular accused product.

The accused-product-specific nature of the determination of whether differences are substantial is illustrated by past doctrine-of-equivalents cases. Thus, the issue in *Graver Tank* was whether an accused welding flux that substituted manganese for the claimed magnesium infringed the patent. 339 U.S. at 610. Other cases have involved substitution of a single hole for a pair of openings in a playpen fastening system,¹⁰ of a pin for a fixation nail in hip surgery,¹¹ of three cabinets for one in a tissue specimen processing apparatus,¹² and of solid fibers for straw-shaped channels in a furnace lining.¹³ In each of these cases, the determination of whether or not the differences were substantial required a

result as the patent claim, *Hilton Davis*, 62 F.3d at 1518, definition of *the claim's* function, way, and result should be a matter of interpretation for the judge. Comparison of *the accused product's* function, way, and result with that definition, however, remains for the jury.

¹⁰ *Tigrett Indus., Inc. v. Standard Indus., Inc.*, 162 U.S.P.Q. 32, 36 (W.D. Tenn. 1967) (equivalent), *aff'd*, 411 F.2d 1218 (6th Cir. 1969), *aff'd by an equally divided Court*, 397 U.S. 586 (1970).

¹¹ *Deyerle v. Wright Mfg. Co.*, 496 F.2d 45, 51-52 (6th Cir. 1974) (not equivalent).

¹² *Miles Lab., Inc. v. Shandon Inc.*, 997 F.2d 870, 876-77 (Fed. Cir. 1993) (equivalent).

¹³ *Hoganas AB v. Dresser Indus., Inc.*, 9 F.3d 948, 954-55 (Fed. Cir. 1993) (not equivalent).

detailed analysis of the accused products, not simply an abstract assessment of the scope of the patent claim.

The assessment of whether an accused product is equivalent to a claimed invention is thus properly viewed as a factual application of the claim, not an expansion of its scope.¹⁴ A finding of equivalents does not change the scope of a patent claim, but merely applies that claim to a specific accused product. It involves skills possessed by juries, such as assessing credibility, rather than analyses for which judges are especially qualified, such as interpretation of legal documents. *See Markman*, 64 U.S.L.W. at 4268. By its nature, moreover, the task of comparing a specific accused product with the claim does not implicate the need for uniformity inherent in construction of the scope of patent claims. *See id.* at 4269.

Contrary to the warnings of some *amici* supporting petitioner, the jury's task is not unguided and unbounded. Instead, it is subject to significant judicial controls. First, the doctrine of "prosecution history estoppel" prevents findings of equivalence that are inconsistent with positions taken by the patentee during the process of obtaining the patent. *Insta-Foam Products, Inc. v. Universal Foam Systems, Inc.*, 906 F.2d 698, 703 (Fed. Cir. 1990). It is properly for the judge to determine what preclusive effect to accord such positions. *Southwall Technologies v. Cardinal IG Co.*, 54 F.3d 1570, 1579 (Fed. Cir. 1995). Second, it is well-established that a

¹⁴ As noted in *Wilson Sporting Goods Co. v. David Geoffrey & Assoc.*, 904 F.2d 677, 684 (Fed. Cir.), *cert. denied*, 498 U.S. 992 (1990):

To say that the doctrine of equivalents extends or enlarges *the claims* is a contradiction in terms. The claims . . . remain the same and application of the doctrine *expands the right to exclude* to "equivalents" of what is claimed.

(Italics in original.)

party practicing the prior art is not liable for infringement under the doctrine of equivalents. *Wilson Sporting Goods Co. v. David Geoffrey & Associates*, 904 F.2d 677, 684 (Fed. Cir.), *cert. denied*, 498 U.S. 992 (1990). Where the accused product simply practices the prior art, the doctrine of equivalents should not be submitted to the jury. Finally, the trial court remains responsible for determining that the evidence is sufficient to support a finding that the accused product is only insubstantially different from the patent claim before submitting a case to the jury under the doctrine of equivalents. *Mendenhall v. Cedarapids*, 5 F.3d 1557 (Fed. Cir. 1993), *cert. denied*, 114 S. Ct. 1540 (1994).¹⁵

For these reasons, the allocation of roles between judge and jury established by the decision below should be affirmed.

III. In View of Prudential Considerations, this Court Should Defer to the Federal Circuit on Detailed Aspects of the Doctrine of Equivalents, Which Involves a Sensitive Balancing of Competing Policies in a Broad Range of Contexts.

Although the continued existence of the doctrine of equivalents and the role of the jury are questions of substantial importance appropriate for decision by this Court, for prudential reasons the Court should decline to spell out the exact contours of the doctrine of equivalents.

¹⁵ As recognized in *Graver Tank*, 339 U.S. at 608-09, the doctrine of equivalents also operates in reverse, to shield an accused product literally meeting a claim's requirements from infringement where it is "so far changed in principle" that it performs "in a substantially different way." See, e.g., *SRI International v. Matsushita Electric Corp.*, 775 F.2d 1107, 1122-25 (Fed. Cir. 1985). The comparison required under this reverse doctrine of equivalents is also an issue of fact that should be the province of the jury.

Like many sound policies, the doctrine of equivalents represents an attempt simultaneously to address competing considerations. It seeks to strike a sensitive balance that both promotes claim definiteness and protects patent rights from mere technical evasions. Inventors should be secure in rewards for their labors, but the application of the doctrine should be predictable so that others can conduct themselves accordingly.

Proper application of the doctrine of equivalents requires that it be continually tailored to the multitude of circumstances presented by newly arising patent claim formats, prosecution histories, contexts of invention, and attributes of accused products. Because the consequences of new circumstances are difficult to assess in advance, this tailoring is best accomplished by deciding new issues as they are presented in concrete terms by actual cases.

The effective operation of the doctrine of equivalents requires a steady stream of appellate caselaw addressing these emerging issues, so that the trial courts decide cases consistently. Inasmuch as the overwhelming majority of real-world doctrine-of-equivalents issues are, and should be, resolved by lawyers' advice without resort to litigation,¹⁶ a well-developed caselaw serves an even more significant purpose by allowing patent practitioners to give the public sound advice on infringement issues.

This Court's broad jurisdiction and limited resources prevent it from deciding more than an occasional case involving the doctrine of equivalents. The Federal Circuit, however, with its nationwide patent-law jurisdiction, decides over a hundred

¹⁶ Cf. *Hickman v. Taylor*, 329 U.S. 495, 514-15 (1947) (Jackson, J., concurring) (observing that their advisory roles make "the lawyer and law office . . . indispensable parts of our administration of justice").

patent cases, including dozens involving the doctrine of equivalents, each year. Unlike this Court, it has the resources to develop and maintain a uniform, detailed, and evolving caselaw regarding the doctrine. Based on their experience in giving advice regarding the doctrine of equivalents, the Association's members believe it is important that the Federal Circuit have the flexibility to maintain that body of law.

In deciding this case, therefore, this Court should paint with a broad brush, leaving to the Federal Circuit the flexibility to establish and adjust the detailed contours of the doctrine of equivalents in future cases. The Court should decline the invitation of various *amici* to articulate a detailed analyses that will rigidly govern all aspects of the doctrine of equivalents until this Court again accepts a case involving the doctrine.¹⁷

Congress made the Federal Circuit the only Court of Appeals with its jurisdiction defined exclusively by subject matter rather than geography. As a result, the Federal Circuit has a special expertise in, and a special responsibility for, patent law. Like this Court and unlike the other Courts of Appeals, the Federal Circuit has a nationwide jurisdiction that ensures uniformity of decision. These characteristics make deference to the Federal Circuit on detailed issues of patent law particularly appropriate.¹⁸ By deciding only the fundamental

¹⁷ For example, the Brief of the United States as Amicus Curiae sets forth a detailed analysis that appears substantively indistinguishable from the doctrine as currently applied by the Federal Circuit, and then, for reasons inexplicable, concludes by proposing remand for proceedings consistent with the analysis. Instead of that disposition, the Association respectfully suggests it would be more appropriate for the Court to affirm the decision below, noting that the Federal Circuit may adjust the details of the doctrine of equivalents as appropriate in future cases.

¹⁸ See *Dennison Manufacturing Co. v. Panduit Corp.*, 475 U.S. 809, 811 (1986) (remanding to obtain "the Federal Circuit's informed opinion on the complex issue of the degree to which the

issues presented by this case, and allowing the Federal Circuit to develop and maintain a consistent and uniform body of detailed law governing the doctrine of equivalents, this Court will promote the "nationwide uniformity in patent law" that Congress sought by creating the Federal Circuit.¹⁹

CONCLUSION

The decision of the Federal Circuit should be affirmed.

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obviousness determination is one of fact"); see also *United States v. Fausto*, 484 U.S. 439, 464 n.11 (1988) (Stevens, J., dissenting) ("Because its jurisdiction is confined to a defined range of subjects, the Federal Circuit brings to the cases before it an unusual expertise that should not lightly be disregarded."); cf. *Cardinal Chemical Co. v. Morton Int'l, Inc.*, 113 S. Ct. 1967, 1979-80 (1993) (Scalia, J., concurring in part) (noting experience of Federal Circuit judges in their specialized patent jurisdiction). See also ROBERT STERN, EUGENE GRESSMAN, STEPHEN SHAPIRO & KENNETH GELLER, *SUPREME COURT PRACTICE* 201 (7th ed. 1993) ("The Supreme Court can, however, be expected to give substantial deference to the views of the Federal Circuit in determining how [patent law] matters should be decided . . .").

¹⁹ H.R. Rep. No. 312, 97th Cong., 1st Sess. 20 (1981); see Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, 96 Stat. 25.